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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER26M1/0610
FITZPATRICK, CELLA, HARPER & SCINTO
277 PARK AVENUE
NEW YORK NY 10172ART. UNIT. PAPER NUMBER
CHANG, J 4526M1
DATE MAILED:

06/10/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2/11/97☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 3-6, 9-17 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-6, 9-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit: 2601

CLAIMS

112 - FIRST PARAGRAPH REJECTION

1. Claims 1, 3-6, 9-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the amended portion of the independent claims 1, 4, 6, such as picking up the name and number from the character train. It is questionable that the original disclosure has such support. As broadly interpreting. The above claimed feature, it appears that the system can read a train of characters, then pick out the name and number. For example, if a train of characters containing a Japanese name (note: this is a Japanese application), an American name and some number, it is questionable that the system can extract these names out, or at least it is not clearly disclosed in the original disclosure, and therefore, it may also be a new matter.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 3-6, 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janku in view of Siemens in further view of Rabideau et al.

Janku teaches a communication terminal that provides facsimile transmission and document storage. Janku, however, differs from the claims in that the claims claim means for recognizing image data, means for registering the image data using a memory control means, searching means, display means and selecting means. Siemens teaches a telephone handset with an optical eye that reads, recognizes, stores and dials telephone numbers. Even though Siemens fails to teach the recognition and registration of alphabets (names), Siemens does teach some of Janku deficiencies, more specifically, Siemens teaches the claimed recognizing means and registering means. Rabideau et al teaches automatic dialing circuit that includes a display to display a plurality of telephone numbers with associated names. Rabideau et al teaches other deficiencies of Janku, more specifically, searching means, display means and selecting means. In Rabideau, the name and phone number and its associated information can be displayed, and their corresponding data can also be changed in the memory (see col. 4, last paragraph in Rabideau). It would have been obvious to one of ordinary skill in the art to substitute the handset 37 of Janku with the handset of Siemens in order to provide the apparatus taught by Janku the

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ease, flexibility and convenience of programming telephone numbers. Furthermore, it would have been obvious to one of ordinary skill in the art to provide the combination above of Janku and Siemens with the automatic dialing circuit of Rabideau et al since it would provide optimum usage of the telephone numbers stored in Siemens' "memory bank." Furthermore, the combination of siemens and Rabideau et al lacks the recognition of alphabets, more specifically as mentioned above, Siemens fails to teach that the optical eye recognized alphabets. The recognition of alphabets by optical readers is well known and widely used and can be easily implemented into any optical reader since it is a programming modification and not a hardware modification, a similar alphabet recognition is in fax, such as shown by Janku. Therefore, it would have been obvious to one of ordinary skill in the art to provide the combination of Janku, Siemens and Rabideau et al., more specifically, Siemens, with optical character recognition (OCR) abilities in order to easily program the telephone numbers and their associated names into the device.

Regarding claim 1, reading means is read on the optical eye 2 of Siemens, the claimed recognizing means and registering means are all inherent since the telephone taught by Siemens is able to recognize and store telephone numbers. The searching means is read on buttons 28 and 60 of Rabideau et al. The display is read

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on display 26 of figure 1 of Rabideau et al. However, the combination above discloses the display of only the information that has been registered. It would have been obvious to one of ordinary skill in the art to display the data that has been read and to display the information that has been recognized simultaneously in order to provide the user with visual verification to obviate any problems that occur due to optical character recognition.

Regarding claim 4, Applicant is directed to the arguments on claim 1. The selecting means is read on button 32 of Rabideau et al. The communication control means is read on processors 65 and 67 of figure 2 in Janku. The storage means is read on hard disk 59 of Janku. And the claimed memory control is read on C.P.U. 40 of Rabideau et al since it stores names and their associated phone numbers in an alphabetical order. And the means for correcting and changing data is read on buttons 28 and 62 of Rabideau et al.

With respect to claim 6, Applicant is directed to the arguments on claim 1 and column 3, line 40 to column 4 line 14 of Rabideau et al.

Regarding claims 3, 13, & 16, Applicant is again directed to column 3, line 40 to column 4 line 14 of Rabideau et al.

With respect to claims 5, 9, 14 and 17, Applicant is directed to column 4 lines 16-41 of Rabideau et al.

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Regarding claim 10, it is evident from figure 1 of Janku that the handset with the reading means would be on an upper surface of the main body.

Regarding claim 11, it is evident that Rabideau et al uses an LCD.

In reference to claims 12 and 15, Applicant is directed to the arguments of claim 1 with respect to the display means.

ARGUMENT

3. In response to the remarks, pages 6-10, the 112, second paragraph, rejection has withdrawn.

In page 7, applicant first argues that Janku and Rabideau et al fails to teach any means for recognizing image data.

The examiner partially agrees with applicant. First, even Janku and Rabideau lack the recognizing means, however, Siemens teaches the above feature. Second, Janku's fax is a scanner similar to Siemens. Third, when a number is needed to store with a name as shown by Rabideau, it is obvious to modify the software to recognize name and number because the concept of recognize the number is well taught by Siemens, and characters (or name) can be scanned in a similar technique as Janku's fax.

In pages 8-9, about extracting the name and number in a character train, see 112, first paragraph rejection above.

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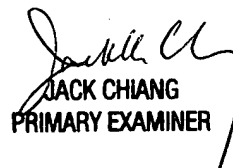
In conclusion, it is believed that the concept of reading the number and name, and storing them for later use is well taught by the combination, see rejection above.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Chiang whose telephone number is (703) 305-4728. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele, can be reached on (703) 305-4701. The fax phone number for this Group is (703) 308-5403.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Chiang/skf
June 6, 1997


JACK CHIANG
PRIMARY EXAMINER